

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 13

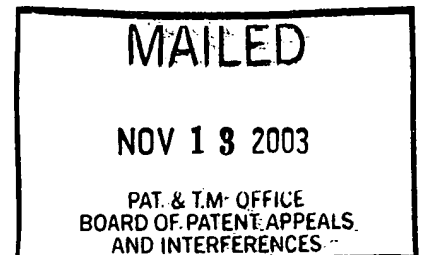
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte GREGORY LORNE POLLON
and TIMOTHY DALE STEWART

Appeal No. 2003-1636
Application 09/677,495

ON BRIEF



Before PAK, OWENS and JEFFREY T. SMITH, *Administrative Patent Judge*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner's refusal to allow claims 1 to 12, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering this decision, we have considered Appellants' arguments presented in the Brief filed November 13, 2002 and the Reply Brief filed March 25, 2003.

THE INVENTION

The Appellants' claimed invention relates to an apparatus for supporting sport practice targets. The apparatus comprises a mounting means adapted for mounting an elongated container to a support structure wherein the elongated container has a roll of flexible sheet material disposed within the interior cavity of the container. A graphic of a sport scene with several sport practice targets is displayed on the sheet material. In an alternative embodiment, sensors are embedded in the sheet material in the vicinity of the sport practice targets. Claim 1 and 9 which are representative of the invention are reproduced below:

1. An apparatus for supporting sport practice targets, comprising:

an elongate [sic, elongated] container having a sidewall defining an interior cavity with an elongate [sic, elongated] access opening extending through the sidewall to the interior cavity;

a roll of flexible sheet material disposed within the interior cavity of the container, the sheet material displaying at least one graphic of a sport practice target, the sheet material having an extended position in which the sheet material extends through the access opening so that the at least one graphic of a sport practice target is visible and a retracted position in which all but a remote peripheral edge of the roll of sheet material is retracted within the container; and

a mounting [sic, a mounting device] adapted for mounting the container to a support structure.

9. An apparatus for supporting sport practice targets, comprising:

an elongate [sic, elongated] container having a sidewall defining an interior cavity with an elongate [sic, elongated] access opening extending through the sidewall to the interior cavity;

a roll of flexible sheet material disposed within the interior cavity of the container, the sheet material displaying a graphic of a sport scene with several sport practice targets, the sheet material having an extended position in which the sheet material extends through the access opening so that the graphic of the sport scene with several sport practice targets are visible and a retracted position in which all but a remote peripheral edge of the roll of sheet material is retracted within the container, the sheet material being biased toward the retracted position;

sensors embedded in the sheet material in the vicinity of the sport practice targets, the sensors being connected to a strike indicator adapted to emit one of an auditory tone and a visual signal when any one of the sport practice targets is struck by a projectile; and

a mounting [sic, a mounting device] adapted for mounting the container to a support structure, the mounting including a first mounting bracket adapted to secure the container in a vertical orientation to a first vertical support and a second mounting bracket adapted to secure the remote peripheral edge of the roll of sheet material to a second vertical support.

CITED REFERENCES

As evidence of unpatentability, the Examiner relies on the following references:

Galloway et al. (Galloway)	5,419,549	May 30, 1995
Thumann	5,505,244	Apr. 09, 1996

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Lapsker et al. (Lapsker)	5,549,302	Aug. 27, 1996
Dubose	5,876,291	Mar. 02, 1999
Lacoste et al. (Lacoste)	6,003,583	Dec. 21, 1999

The Examiner rejected claims 1, 3, 4, 6 and 7 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose and Lacoste; claim 5 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose and Thumann; claim 2 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose and Lacoste as applied to claim 1 further in view of Galloway; claim 8 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose and Lacoste as applied to claim 1 further in view of Lapsker; claims 9-11 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose, Thumann and Galloway; and claim 12 under 35 U.S.C. § 103(a) as obvious over the combination of Dubose, Thumann and Galloway as applied to claim 9 further in view of Lapsker. (Paper no. 4, pp. 2-4).

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1 and 9. In rejecting the subject matter of claim 1, the Examiner's relies on the combination of Dubose and Lacoste and in rejecting the

subject matter of claim 9, the Examiner's relies on the combination of Dubose Thumann and Galloway. Therefore, we will limit our discussion to these references.

To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention. *See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient to establish a prima facie case of obviousness based on prior art references disclosing the components of a patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

The Examiner rejected claim 1 over the combination of Dubose and Lacoste. According to the Examiner, "Dubose discloses the claimed device with the

exception of the container. However, as disclosed by Lacoste it is known to use a container to store screens for covering door openings. It would have been obvious to one of ordinary skill in the art to have done the same with Dubose's device to make it more convenient to use." (Paper no. 4, p. 2).

We cannot uphold the Examiner's rejection. Appealed claim 1 requires the apparatus to comprise an elongate container having a sidewall defining an interior cavity with an elongated access opening extending through the sidewall to the interior cavity and a mounting means adapted for mounting the container to a support structure.

Dubose does not describe or suggest such a container. Dubose discloses the golf practice screen is hung in the frame of a door using elongate springs. Dubose discloses that the practice screen is removed and rolled for storage. (Col. 2, ll. 4-20). Dubose also discloses that the practice screen is designed to catch the driven golf ball and return it to the user at a slow velocity. (Col. 2, ll. 49-51).

Lacoste describes a door screening system that comprises a screen assembly storage chamber for storing a retracted spooled screen therein. (See Figure 1). The screen assembly includes a length of plastic screening having rigid aluminum vertical supports (38) spaced along the length thereof. The screen assembly comprises a rigid metal guide support trackway section (16a and b). (Cols. 3-4).

The Examiner has not directed us to adequate motivation or suggestion for employing the door screening system of Lacoste as a means for storing and hanging the golf practice screen. Dubose and Lacoste are directed to using different hanging mechanism for different purposes. The Examiner has not explained why Lacoste's screening system would have been suitable for use as a golf target hanging support mechanism that is capable of catching a driven golf ball and return it to the user at a slow velocity as required by Dubose. The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Examiner rejected claim 9 over the combination of Dubose, Thumann and Galloway. According to the Examiner, "Dubose discloses the claimed device with the exception of the container and the sensor. However, as disclosed by Thumann it is known to use a container to store screens for covering door openings. It would have been obvious to one of ordinary skill in the art to have done the same with Dubose's device to make it more convenient to use. Further as disclosed by Galloway it is known in the art to use sensors on such devices as typified by Galloway. It would have been obvious to one of ordinary skill in the art to have

added such a sensor to Dubose's screen as well to add further interest for the user. ”
(Paper no. 4, p. 3).

Thumann discloses a retractable covering for a door comprising a housing mounted on one side of the door and a latching strip mounted on the opposite side of the door. The housing contains a roll of screen material that can be pulled out of the housing across the door opening and latched on the opposite side of the door.

Thumann states “the present invention will be described with particular reference to a retractable covering--e.g., a screen for selectively a covering door opening in a house or the like--it is to be understood that the retractable covering of the present invention can be used with any opening in a structure of any type wherein it is desired to eliminate a hinged covering for the door opening.” (Col. 2, ll. 51-59).

The Examiner has not directed us to adequate motivation or suggestion for employing the retractable covering described by Thumann as a means for storing and hanging the golf practice screen described by Dubose. Dubose and Thumann are directed to using different hanging mechanisms for different purposes. The Examiner has not explained why Thumann's retractable covering system would have been suitable for use as a golf target hanging support mechanism that is capable of catching a driven golf ball and return it to the user at a slow velocity as required by Dubose. As stated above, the mere fact that the prior art could be modified as

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proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch, supra.*

The use of sensors on practice targets as described by Galloway does not provide motivation or suggestion for employing the retractable covering described by Thumann as a means for storing and hanging the golf practice screen described by Dubose.

The record indicates that the motivation relied upon by the Examiner for using the retractable screen storage system of either Lacoste or Thumann for the practice target of Dubose comes from the Appellants' description of their invention in the specification rather than coming from the applied prior art and that, therefore, the Examiner used impermissible hindsight in rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

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